

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 1-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,602,185 to Uchikubo (hereinafter "Uchikubo") in view of U.S. Patent No. 6,659,939 to Moll et al., (hereinafter "Moll").

In response, The Applicant respectfully traverses the Examiner's rejection under 35 U.S.C. § 103(a) for at least the reasons set forth below.

In the Official Action, the Examiner argues that Uchikubo shows all of the features of the claims with regard to a similar system involving an operating room (5) and a remote control room (6). The Examiner admits that Uchikubo does not disclose a third control system located in a secondary support room. However, the Examiner argues that the third control system located in a secondary support room would have been obvious in light of the Moll reference.

The Applicant respectfully disagrees for at least the following two reasons.

1. **NO MOTIVATION OR SUGGESTION TO
COMBINE UCHIKUBO AND MOLL**

Firstly, the Applicant respectfully submits that there is no motivation or suggestion to combine the remote surgery support system of Uchikubo with the tele-surgical system of Moll. The Examiner goes on to list several motivations for combining the systems of Uchikubo and Moll. However, none of such reasons are related to the objective of the present invention, namely to prevent the operator in the operating room from receiving all of the information units from supporting rooms. Therefore, unnecessary information can be "filtered" and/or integrated by a single primary support room, which prevents the operator from receiving unnecessary information (see page 9, lines 13-21 of the present disclosure) and

also leads to an operation that is performed correctly, rapidly and reliably (see page 16, lines 4-8 and page 18, lines 8-9 of the present disclosure). Neither Uchikubo nor Moll suggest such problems nor contemplate their solution.

Recently the U.S. Court of Appeals for the Federal Circuit (the “Federal Circuit”) restated the legal test applicable to rejections under 35 U.S.C. § 103(a) (*In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir., July 15, 1998)). The Court stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” To prevent the use of hind sight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Instead, the Board merely invoked the high level of skill in the field of the art. If such a rote indication could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness construct **the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.**

In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) (citations omitted, emphasis added).

More recently, the Federal Circuit again dealt with what is required to show a motivation to combine references under 35 U.S.C. § 103(a). In this case the court reversed the decision of the Board of appeals stating:

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other-in combination with each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, nor does the Board make specific-or even inferential-findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any factual findings that might serve to support a proper obviousness analysis.

In re Dembiczak, 50 USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) (citations omitted).

Thus, from both *In re Rouffet* and *In re Dembiczak* it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them. This the Examiner has not done. As discussed above, the Examiner lists several motivations for combining the systems of Uchikubo and Moll. However, none of such reasons are related to the objective of the present invention. Neither Uchikubo nor Moll suggest the problems in the art addressed by the present invention nor contemplate their solution. The Examiner also fails to indicate that the art in general understood the problems in the art or contemplated a solution thereto. Therefore, those of ordinary skill in the art would not be motivated or suggested to look to Moll to combine the teachings therein with those of Uchikubo. Such a motivation or suggestion could have only been gleaned from the present disclosure upon learning of the objectives of the present invention.

Thus, the Applicant respectfully submits that the Examiner has used impermissible hindsight to reject claims 1-21 under 35 U.S.C. § 103(a). As discussed above, the Federal Circuit in *In re Rouffet* stated that virtually all inventions are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the

prior art. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness. Applicants respectfully submit that the Examiner has not met this burden.

In light of the state of the law as set forth by the Federal Circuit with regard to the motivation to combine the cited references, the applicant respectfully submits that the rejection for obviousness under 35 U.S.C. 103(a) lacks the requisite motivation and must be withdrawn.

2. **COMBINATION OF UCHIKUBO AND MOLL FAIL TO DISCLOSE OR SUGGEST ALL OF THE FEATURES OF THE CLAIMS**

Secondly, even if the combination of Uchikubo and Moll is proper (which it is not), their combination still does not show all of the features of the claims. As discussed above, Uchikubo shows the features of the claims with regard to a system involving an operating room and a remote control room. Moll shows two surgeons that input information or instructions to **the same operating room**. Therefore, the combination of Uchikubo and Moll does not show one or more secondary support rooms for (1) receiving and processing information from the operating room and (2) and transmitting a processing result (as secondary support information) **to a primary support room** (which is not the operating room) as recited in the claims.

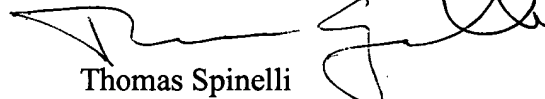
Furthermore, the combination of Uchikubo and Moll does not show (1) generating primary support information based on an image signal from the operating room and the secondary support information from the secondary support room and (2) and transmitting the same to the operating room as is also recited in the claims.

Thus, independent claims 1, 8, and 15 are not rendered obvious by the cited references because neither the Uchikubo patent nor the Moll patent, whether taken alone or in combination, teach or suggest a remote operation support system or method having at least the features discussed above. Accordingly, claims 1, 8, and 15 patentably distinguish over the prior art and are allowable. Claims 2-7, 9-14, and 16-21, being dependent upon claims 1, 8, and 15, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-21 under 35 U.S.C. § 103(a).

Lastly, claim 1 has been amended to delete the word "simultaneously." The remote operation support system described in the present disclosure is not limited to such a configuration. Thus, the amendment to claim 1 is fully supported in the original disclosure. Therefore, no new matter has been entered into the disclosure by way of the present amendment to claim 1.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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